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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,313	01/23/2002	Chad Stevens	10013604-01	8004

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EXAMINER

OSORIO, RICARDO

ART UNIT

PAPER NUMBER

2673

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,313

Applicant(s)

STEVENS ET AL.

Examiner

RICARDO L OSORIO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9,10 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9,10 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “user interface device for enabling the electronic paper display to present a user with a plurality of reference images grouped for display on the electronic paper display device” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 9, 10, 13, 16, 18, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Comiskey 6,473,072).

Regarding claims 1, 19, and 21, Comiskey teaches of a whiteboard apparatus (Fig. 12a, reference character 120, and col. 14, lines 50-52) comprising:
an electronic paper display device configured to display an image (col. 13, lines 58-61);
and a writing surface (Fig. 12b, reference character 129) arranged in superimposed relationship with the electronic paper display device (col. 14, lines 47-49). Note that the protecting layer or coating is the superimposed writing surface). Also, Comiskey further teaches of user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image (col. 14, lines 47-53 and col. 16, lines 48-68. Any underlying image over which the user may write constitutes a reference image). Also, the drawing system of Comiskey can store and recall images, from a memory device, which clearly provides for selection from different stored reference

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images (see Comiskey, col. 7, lines 2-6). Also, Comiskey teaches that an interactive (user interface) series of images, or plurality of images, can be downloaded on the drawing screen (col. 6, lines 60-68). Although not directly mentioned, since in Comiskey images can be recalled from memory (a menu list or file names at least) and also an interactive series of images can be downloaded, the device of Comiskey inherently can select one interactive displayed image as the reference, or predefined image (see col. 16, line 60-col. 17, line 6).

Regarding claim 2, Comiskey teaches of the electronic paper display device comprising:

a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Regarding claim 3, Comiskey teaches that the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 4, Comiskey further teaches of a network interface device configured for communication with a communication network and wherein the image displayed on the electronic paper display is received via the communication network (col. 16, lines 48-52 and 60-67. Note that the communications device and appropriate logic circuitry used to download information from the web or, internet, requires a network interface).

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Regarding claim 9, Comiskey further teaches of a scanning device configured to convert a document to an electronic image to be displayed on the electronic paper display device (col. 17, lines 2-6).

Regarding claims 10, 22, 23 and 25, Comiskey teaches of a method comprising the steps of :

Providing an electronic paper display device configured to display an image (col. 13, lines 58-61) on a whiteboard (Fig. 12a, reference character 120, and col. 14, lines 50-52); arranging a writing surface (Fig. 12b, reference character 129) in superimposed relationship with the electronic paper display device (col. 14, lines 47-49. Note that the protecting layer or coating is the superimposed writing surface); and furthermore enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image and displaying the image on the electronic paper display device (col. 14, lines 47-53 and col. 16, lines 48-68. Any underlying image over which the user may write constitutes a reference image). Also, the drawing system of Comiskey can store in memory device and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6). Also, Comiskey teaches that an interactive series of images, or plurality of images, can be downloaded on the drawing screen (col. 6, lines 60-68). Although not directly mentioned, since in Comiskey images can be recalled from memory (a menu list or file names at least) and also an interactive series of images can be downloaded, the device of Comiskey inherently can select one

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displayed interactive image as the reference, or predefined image (see col. 16, line 60-col. 17, line 6).

Regarding claim 13, Comiskey further teaches than the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 16, Comiskey further teaches of scanning the image from a document (col. 17, lines 2-3).

Regarding claim 18, Comiskey further teaches that the electronic display device comprises: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey.

Comiskey does not precisely teach of hardware buttons corresponding to a predetermined image of the plurality of reference images stored in the memory.

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However, Comiskey teaches of recalling images from memory and of downloading a series of interactive images (see col. 16, line 60-col. 17, line 6). To recall images from either a local memory device, or a server, software buttons (options) needs to be selected. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have either the hardware buttons, or software buttons, in the device of Comiskey because it is a well known choice of the user or manufacturer of the system to have software buttons, hardware buttons, or a combination of both, wherein the same result is obtained and one type of button can be substituted for the other.

5. Claims 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al. (6,473,072) in view Chery et al (6,177,927).

Regarding claims 5, 14 and 15, Comiskey fails to teach that the reference, or predefined, image comprises a Cartesian plane, or a template of a flowchart.

Chery teaches of a reference image comprising a Cartesian plane, or a template of a flowchart: Chery teaches of a large variety of background, or reference, or predefined, images over which a user may write on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43). Finally, Chery teaches of a Cartesian coordinate that is transposed on the writing surface; the corners of the monitor image area

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are defined as (0,0), (0,H), (W,0) and (W,H) (see Chery, Figs. 11B and 11C, and col. 49, lines 47-63)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a reference image showing a Cartesian plane, or template, as taught by Chery, in the device of Comiskey, so that the user can write a stroke on the writing surface and know the precise stylus location (see Chery, col. 49, line 66-col. 50, line 2). Also, it is well known in the art of graphics that a program such as CAD can be used to create any desired graphical image such as a Cartesian coordinate, a graph, flowchart, etc.

6. Claim 17 and 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey (see above) in view of applicant's admitted prior art (APA, hereafter).

Regarding claim 17 and 26, Comiskey fails to teach of printing the image displayed on the electronic paper display and the contents of the writing surface. APA teaches of printing the combined scan result result of the predefined image displayed on the electronic paper display and the contents of the writing surface (see application, page 2, lines 2-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the combined image, as taught by APA, in the device of Comiskey because it is well known in the art of electronic whiteboards to integrate a printer which can print both original images and updated images, for example, to provide an updated hard copy of the lecture or conference to all the participants.

Response to Arguments

7. Applicant's arguments filed 8-23-2004 have been fully considered but they are not persuasive.

The drawing system of Comiskey can store in memory device and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6). Also, Comiskey teaches that an interactive series of images, or plurality of images, can be downloaded on the drawing screen (col. 6, lines 60-68). Although not directly mentioned, since in Comiskey images can be recalled from memory (a menu list or file names at least) and also an interactive series of images can be downloaded, the device of Comiskey inherently can select one displayed interactive image as the reference, or predefined image (see col. 16, line 60-col. 17, line 6).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 703 305-2248. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 703 305-4938.

Any response to this action should be mailed to:

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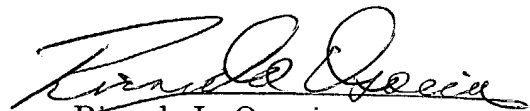
or faxed to:

703 872-9306 (for Technology Center 2600 only)

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ricardo L. Osorio

Examiner

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RLO

September 17, 2004